UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROSHI TAKANASHI
and TOMOYA KUDO

Appeal No. 2005-1512
Application No. 09/739,750

ON BRIEF

Before WALTZ, JEFFREY T. SMITH and PAWLIKOWSKI, ***Administrative Patent Judges***.

JEFFREY T. SMITH, ***Administrative Patent Judge.***

REMAND TO THE EXAMINER

This case is not ripe for meaningful review and is, therefore, remanded to the Examiner for appropriate action consistent with the views expressed below.

On pages 8 and 9 of the Answer dated November 4, 2003, the Examiner provides a discussion of a declaration filed in the parent application 09/262,077 dated December 20, 2000. The Examiner states "[t]he Examiner notes that the comment '% by weight' has been inked in with a line pointing to the column titled 'Addition Amount of component E' on this copy of the declaration. This comment was not present on the executed version of the declaration submitted to the Office on December 20, 2000. Furthermore, the comment contradicts the defined units for X found on pg. 3 of the declaration as 'X parts by weight' sworn to be true by the declarant."

This application has been previously remanded to the Examiner on March 29, 2005, by the Board of Patent Appeals and Interferences (BPAI). In this paper it was indicated that the declaration filed on September 25, 2000 could not be located in the Image File Wrapper (IFW) for the present application.

In response to this Remand, the Examiner in the communication mailed April 11, 2005 stated that "[a] copy of the September 25, 2000 Declaration was missing from the Image File Wrapper. The Examiner has located the copy and the copy will be scanned into the Image File Wrapper."

On June 13, 2005, a copy of a declaration was faxed to the BPAI.[1] The ink markings discussed on pages 8 and 9 of the Answer, and identified above, do not appear in the copy of the declaration received by the BPAI. Consequently, this document does not appear to be the same document considered by the Examiner when writing the Answer.[2] In order for the merits panel of the BPAI to review the record on appeal, the document including all ink markings which may have been added after the original date of submission must be present.[3] It is important that the record presented to the BPAI for consideration be the same as the record established by the Examiner and Appellants. A meaningful review of this record cannot occur unless the documents submitted by Appellants for consideration have been entered into the record.

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[1] The date of this transmission has been determined from the transmission information appearing at the top of the document. We note that this document has not been scanned into the IFW for the present application.

[2] It appears that the Examiner retrieved a copy of the original declaration filed in the parent application.

[3] Without this document it cannot be determined if the described markings have been authorized by the declarant and whether other additions to the document have been made for consideration.

Thus, we remand this application to the Examiner to have the copy of the declaration, as submitted in the present application, dated September 25, 2000 scanned into the IFW for the present application. If the copy of the declaration is not in the Examiner's possession, the Examiner should contact the Appellants to have the declaration re-submitted.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is ***not*** made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) does not apply.

This application, by virtue of its "special" status, requires immediate action, see MPEP & 708.01 (8th ed. May 2004), item (D). It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

REMAND

THOMAS A. WALTZ
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

BEVERLY A. PAWLIKOWSKI
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

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